

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated June 6, 2006 (hereinafter Office Action) have been considered. Claims 1-52 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1, 6-9, 13-17, 22-24, 26-31, 36-44 and 47-51 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0101519 by Myers (hereinafter "Myers"). The Applicants respectfully submit that the claims as originally filed are not anticipated by *Myers*. However, in order to facilitate prosecution of the application and in a *bona fide* attempt to advance the application to allowance, the Applicants present this response with amendment to clarify particular aspects of the claimed invention.

Claim 1 has been amended to indicate that digital content is created via a mobile communications device that is capable of communicating via a wireless network. Identifiers are obtained via the mobile communications device. The identifiers correspond to entities that include one or more other mobile terminals, and the identifiers are registered with the created content at the mobile device. Independent Claims 30, 40, 44, and 48 have been similarly amended, and at least set forth that the entities associated with the creation of content include mobile terminals capable of communicating via wireless networks, and these terminals provide identifiers that are associated with the created content. The Applicants assert that *Myers* fails to anticipate independent Claims 1, 30, 40, 44, and 48, as originally filed, and particularly amended.

To anticipate a claim the reference must teach every element of the claim, and it is respectfully submitted that *Myers* does not meet this standard. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Applicants set forth that *Myers* at least fails to disclose identifiers being sent from mobile communications devices to a mobile device that creates digital content. *Myers* is directed to electronically cataloging photographs based on a transponder signal that uniquely identifies the subject of the

photograph. *Myers* describes the transponder signal as being transmitted by a generator that is attached to an item such as a room key. (*Myers*, para. 0018).

Regarding Claims 1, 30, 40, 44, and 48, *Myers* is silent as to the identifiers being sent by mobile terminals. *Myers* describes a specialized transponder device that issued and carried for a specific purpose, such as being associated with a room key. *Myers* fails to expressly or inherently describe the identifiers are transmitted from a device such as a mobile terminal. *Myers* also describes the transponder signal as being received by a detection unit of the digital camera (*Myers*, para. 0018), or by a separate detection unit (*Myers*, para. 0031) but does not expressly or inherently show the identifier being received by a mobile terminal capable of being communicating via a wireless network. At most, *Myers* describes that the camera may have an infrared interface for point-to-point downloads to a computer. (*Myers*, para. 0023), however an infrared interface would not be considered a wireless network by one of ordinary skilled in the art, nor would a digital camera with an infrared interface be considered a communications terminal that communicates via a wireless network. Therefore, Applicants respectfully submit that *Myers* fails to disclose all of the limitations of Claims 1, 30, 40, 44, and 48, and therefore these claims are allowable over *Myers*.

Claims 6-9, 13-17, 22-24, 26-29 depend from independent Claim 1; Claims 31 and 36-39 depend from independent Claim 30; Claims 41-43 depend from independent Claim 40; Claim 47 depends from independent Claim 44; and Claims 49-51 depend from independent Claim 48. These dependent claims also stand rejected under 35 U.S.C. §102(e) as being anticipated by *Myers*. While Applicant does not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency or the taking of Official Notice, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 30, 40, 44, and 48,. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Myers*. Therefore, dependent Claims 6-9, 13-17, 22-24, 26-29, 31, 36-39, 41-43, 47, and 49-51 are also in condition for allowance.

Claims 10-12, 25, 32 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Myers*. The Applicants respectfully traverse the rejection. Regarding Claim 35, the Examiner takes Official Notice that it would be obvious to modify *Myers* to transmit the query and response signals using the Bluetooth protocol. Regarding Claims 10-11, 25 and 32, the Examiner takes Official Notice that it would be obvious to modify *Myers* to map identifiers of interest to communications addresses of the entities associated with the digital content. Regarding Claim 12, the Examiner takes Official Notice that it would be obvious to modify *Myers* to transmit the list of obtained identifiers to the addresses of the entities associated with the digital content.

Applicants respectfully assert that neither transmitting the query and response signals using the Bluetooth, nor using addresses of the entities associated with the digital content for mapping and transmitting lists of identifiers, constitute facts outside of the record which are capable of instant and unquestionable demonstration as being well-known in the art. The reference relied on in the Office Action, for example, fail to disclose this purportedly “well known” fact. Applicants contend that reasonable doubt exists regarding the circumstances justifying the Examiner’s exercise of Official Notice, and request that the Examiner provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Applicants reserve the opportunity to respond to the Examiner’s comments concerning any such judicially noticed facts.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Taking Official Notice of the above-discussed “facts” disregards the requirement of analyzing Applicants’ claimed subject matter *as a whole*. Applicants respectfully reiterate the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based.

MPEP § 2144.03.

In particular regarding Claims 10-12, 25, and 32, Applicants note that that would be inappropriate to modify *Myers* as suggested by the Examiner, when viewing both the claimed subject matter and the prior art references as a whole. “Not only must the claimed

invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). As described above, *Myers* describes transmitting identifiers via a transponder, and the only specifically described identifier in *Myers* is a room number (*Myers*, para. 0034). *Myers* does not describe the transponder as being capable of communicating via a network, nor does *Myer* describe the transponder as having any other attribute that would require an "address" as the term is known in the art. Further, because the transponder is described in *Myers* as a simple transmitter attached to a key, it would be unreasonable to suggest that such a device is capable of receiving transmitted data of the types that are set forth in Claims 11, 12, 25, 32. Therefore, the Applicants respectfully submit it would not be obvious to modify *Myers* as suggested by the Examiner, particular when both *Myers* and the claims are viewed as a whole.

Further, Applicants note that Claims 10-12 and 25 depend from independent Claim 1 and Claims 32 and 35 depends from independent Claim 30. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Myers*. The Examiner did not rely on the taking of Official Notice to cure the deficiencies of *Myers* described above regarding independent Claims 1 and 30, nor does *Myers* provide such a remedy. Therefore, dependent Claims 10-12, 25, and 32 are in condition for allowance for this additional reason.

Claims 2-5, 33-34 and 45-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Myers* in view of U.S. Publication No. 2002/0008622 by Weston et al. (hereinafter "Weston"). Claims 18-20 and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Meyers* in view of U.S. Publication No. 2002/0132616 by Ross (hereinafter "Ross"). Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Myers* in view of *Ross* as applied to claim 20, and further in view of *Weston*. Applicants respectfully traverse the rejections.

According to MPEP §2142, to establish a *prima facie* case of obviousness under 35 U.S.C. §103:

- 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

All three criteria must be met to establish *prima facie* obviousness of a claim. The Applicants respectfully submits that, at least, the combination of *Myers* in view of *Weston* does not teach or suggest all of the limitations of Claims 2-5, 33-34 and 45-46, nor does combination of *Myers* with *Ross* teach all of the limitations of Claims 18-20 and 52, nor does the combination of *Myers* and *Ross* with *Weston* teach all of the limitations of Claim 21.

Regarding Claims 2-5, 33-34, and 45, the Office Action recognizes that *Myers* fails to teach or suggest filtering the obtained identifiers to obtain, but according to the Examiner, this filtering is taught in *Weston*. *Weston* describes a system and method for automated photo/video capture and retrieval using RFID tags. *Weston* describes that a personal or group identifier (UPIN and UGIN) may be read from the RFID tags by image capture equipment, and any images taken by the equipment are stored and indexed by these identifiers. However, the Applicants respectfully disagree that *Weston* teaches or suggests filtering these identifiers, and associating the filtered identifiers with the images.

Weston states that “a reader 220 preferably reads the tag of each person substantially within view of the camera.” (*Weston*, para. 0042). The identifiers associated with those tags are stored with the images, but *Weston* does not teach or suggest that the identifiers are filtered or otherwise selectively reduced before indexing with the images, so that only identifiers of interest are indexed with the images. The Examiner implies that the use of the UPIN and UGIN to index and retrieve the images (Office Action, top of p. 6, which relies on para. 0022 of *Weston*) is equivalent to “filtering.” The Applicant disagrees, noting that

this selection and retrieval is not used to determine identifiers of interest that are associated with the content, because the UPIN and UGIN are already associated with the images before the index and retrieval occurs. Thus *Weston* fails to teach filtering operation that result in a resulting list of identifiers or identifiers of interest that are as then associated with content, as described in Claims 2-5, 33-34, and 45. The combination of *Myers* and *Weston*, therefore, fails to teach or suggest all of the limitations of Claims 2-5, 33-34, and 45.

Further, regarding Claims 3 and 4 neither *Weston* nor *Myers* teach or suggest the entities that provide the identifiers have an address or that the entities are capable of receiving any data. As described above, *Myers* describes a transponder that provides an identifier, and is silent on any addressability or networkability of the transponder. *Weston* describes the UPIN and UGIN as being provided via RFID tags, and is silent as to any addressability or networkability of the RFID tag. Further, these references are silent on the transponders or RFID tags being capable of receiving data such as identifiers, nor would one skilled in the art presume as such. For these additional reasons, the combination of *Myers* and *Weston* fails to teach all of the limitations of Claims 3 and 4.

Regarding the rejections of Claims 18-20 and 52, the Office Action recognizes that *Myers* fails to teach or suggest a terminal requesting transmission of the identifiers from a network service, but nonetheless suggests that this is taught by *Ross*. The Applicants disagree, noting that *Ross* merely describes sharing of data between proximately located devices when it is determined that “profiles” match (*Ross*, para. 0021). However, *Ross* does not teach or suggest that this data sharing occurs in conjunction with a content creation event, nor does *Ross* teach or suggest an identifiers associated with a content creation event that are obtained via a network. Therefore the combination of *Myers* and *Ross* therefore fails to teach or suggest all of the limitations of Claims 18-20 and 52.

Applicants further respectfully submit that there is no motivation to combine *Myers* with *Ross*, nor would there be a reasonable expectation of success in making such a combination. The mere fact that references can be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination.

In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Even assuming arguendo that

the references relied upon were individually known in the art, this is insufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The proffered motivation in the Office Action, that one skilled in the art would have modified *Myers* to “for the advantage of providing an alternate way to obtain identifiers of nearby devices to the mobile terminals,” is conclusory. It is respectfully submitted that the proffered motivation provided in the Office Action does not rise to the level of clear and particular actual evidence.

Further, because *Myers* fails to describe transponders that are network capable, nor would one of ordinary skill in the art assume expect that a transponder is network capable, it would not be reasonable to expect that the network service of *Ross* would work with non-networkable transponders of *Myers*. Therefore one skilled in the art would have no motivation to combine these reference, nor would such a one have a reasonable expectation that such a combination would succeed. Thus the Applicants respectfully suggest that a *prima facie* case of obviousness has not been established with respect to Claims 18-20 and 52.

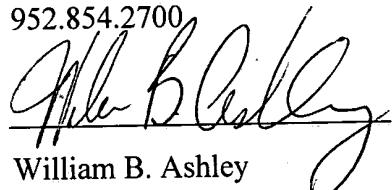
In addition to the arguments presented above, the Applicants note that, for the rejections of Claims 2-5, 18-21, 33-34, 45-46, the Examiner relies on *Myers* as teaching the substance of the claims from which these claims ultimately depend, namely independent Claims 1, 30, and 44, respectively. The Examiner does not rely on *Ross* or *Weston* as providing a remedy to the deficiencies of *Myers* as it pertains to independent Claims 1, 30, and 44, nor do *Ross* or *Weston* provide such a remedy. Thus, because neither *Myers*, *Ross*, nor *Weston* teach at least the recitations of amended Claims 1, 30, and 44, a combination of *Myers*, *Ross*, and *Weston* fails to teach these recitations. Further, a combination of *Myers*, *Ross*, and *Weston* fails to suggest the invention as set forth in Claims 1, 30, and 44, as there is no reference to at least creation of content that includes mobile terminals capable of communicating via wireless networks, and where these terminals provide identifiers that are associated with the created content. While other requisites of establishing *prima facie* obviousness may also be absent, the Applicants respectfully submit that the cited

combination of references at least fails to teach or suggest all of the claim limitations. For at least this reason, Claims 2-5, 18-21, 33-34, 45-46 are not rendered obvious by the combinations of *Myers*, *Ross*, and *Weston*, and withdrawal of the rejection is respectfully solicited.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.067PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at to discuss any issues related to this case.

Respectfully submitted,

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